

Appl. No. : 10/081,712
Filed : February 21, 2002

REMARKS

By way of summary, Claims 1-35 were originally filed in the present application. In response to a *Restriction Requirement*, Applicants canceled Claims 1-22 and 35 and added Claims 36-43. With this Amendment, Applicants have amended Claims 23, 36, and 40 and canceled Claim 37. Claims 44 and 45 have been added. Thus, Claims 23-34, 36, and 38-45 are pending in the present application

Claims Indicated As Allowable Have Been Rewritten

Applicants acknowledge with appreciation the indication that the subject matter of Claims 37 and 40 would be allowable if rewritten into independent form. The Examiner objected to Claims 37 and 40 as being dependent upon a rejected base claim, but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With this Amendment, the allowable dependent Claim 37 has been incorporated into the independent base Claim 36. Thus, Claim 36 is in condition for allowance.

Claim 40 has been amended in independent form, incorporating limitations of the respective base claim and any intervening claims. Thus, Applicants respectfully submit that Claim 40 is in condition for allowance.

Claims 23-25, 28, 29, 36, 38, 39, and 43 Are Patentable Over Mair et al.

Claims 23-25, 28, 29, 36, 38, 39, and 43 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Publication No. 2002-0147462 to Mair et al. (“Mair”). Claims 26, 27, 30-34, 41, and 42 were rejected under 35 U.S.C. § 103(a) as unpatentable over Mair. Applicants respectfully submit that the pending claims are novel and non-obvious over the cited reference.

Mair does not disclose each and every limitation of Claims 23-34. For example, amended Claim 23 recites, *inter alia*, an intra-bronchial device that comprises a one-way valve, and the intra-bronchial device precludes air from being inhaled through an air passageway into a lung portion when inserted into the air passageway communicating with the portion of the lung. Applicants respectfully submit that the prior art of record, either individually or in combination, does not teach or suggest the unique combination of limitations recited by amended Claim 23. Dependent Claims 24-34 are allowable as depending from an allowable base claim, as well as for

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novel and non-obvious combination of elements recited therein. Thus, Claims 23-34 are in condition for allowance.

As discussed above, the allowable dependent Claim 37 has been incorporated into the independent base Claim 36. Thus, amended Claim 36 is in condition for allowance. Dependent Claims 38 and 39 are allowable as depending from an allowable base claim, as well as for novel and non-obvious combination of elements recited therein.

Claim 40 has been amended in independent form, incorporating limitations of the respective base claim and any intervening claims. Dependent claims 41-43 are allowable as depending from an allowable base claim, as well as for novel and non-obvious combination of elements recited therein. Thus, Claims 36 and 39-43 are in condition for allowance.

Added Claims

Claims 44 and 45 have been added. These claims are fully supported by the application as filed. Accordingly, no new matter has been added by this amendment. Consideration of new Claims 44 and 45 is respectfully requested.

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Conclusion

Applicants do not agree with the characterization of the reference nor the rejections set forth by the Examiner. Nevertheless, to expedite the prosecution of the present application, Applicants have amended some of the claims. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby. Applicants reserve the right to seek broader claims, e.g., with scope similar to that of previously pending claims in a continuation application. Applicants respectfully submit that the pending claims are novel and non-obvious over the art of record.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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